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Reply Brief Under 37 C.F.R. §41.41 (17 sheets)

Application Number 09/528,693
Confirmation No.: 5947
Filing Date: 20 March 2000
Document Submission Date: 22 March 2006
Docket: 2000P07518US01 (1009-026)

Art Unit: 3627
Examiner: Fischer, Andrew J.
Inventor: Wright, James

Pages: 20

22 Mar 2006

Date

Eden Brown

Name of Certifier

Eden Brown

Signature of Certifier

MAR 22 2006

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PTO/SB/17 (12-04)

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Fees pursuant to the Consolidated Appropriations Act, 2005 (H.R. 4818).**FEE TRANSMITTAL
For FY 2005** Applicant claims small entity status. See 37 CFR 1.27

TOTAL AMOUNT OF PAYMENT (\$)

500.00

Complete if Known

Application Number	09/528,693
Filing Date	20 March 2000
First Named Inventor	Wright, James
Examiner Name	Flascher, Andrew J.
Art Unit	3627
Attorney Docket No.	2000P07518US01 (1009-026)

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FEE CALCULATION**1. BASIC FILING, SEARCH, AND EXAMINATION FEES**

Application Type	FILING FEES		SEARCH FEES		EXAMINATION FEES	
	Small Entity	Fee (\$)	Small Entity	Fee (\$)	Small Entity	Fee (\$)
Utility	300	150	500	250	200	100
Design	200	100	100	50	130	65
Plant	200	100	300	150	160	80
Reissue	300	150	500	250	600	300
Provisional	200	100	0	0	0	0

2. EXCESS CLAIM FEES**Fee Description**

Each claim over 20 or, for Reissues, each claim over 20 and more than in the original patent

50 .25

Each independent claim over 3 or, for Reissues, each independent claim more than in the original patent

200 100

Multiple dependent claims

360 180

Total Claims	Extra Claims	Fee (\$)	Fee Paid (\$)
- 20 or HP =	0	50	0

HP = highest number of total claims paid for, if greater than 20

Multiple Dependent Claims	
Fee (\$)	Fee Paid (\$)

0

Independent Claims	Extra Claims	Fee (\$)	Fee Paid (\$)
- 3 or HP =	0	200	0

HP = highest number of independent claims paid for, if greater than 3.

3. APPLICATION SIZE FEE

If the specification and drawings exceed 100 sheets of paper, the application size fee due is \$250 (\$125 for small entity) for each additional 50 sheets or fraction thereof. See 35 U.S.C. 41(a)(1)(G) and 37 CFR 1.16(s).

Total Sheets	Extra Sheets	Number of each additional 50 or fraction thereof	Fee (\$)	Fee Paid (\$)
- 100 =	/ 50 =	0 (round up to a whole number)	250	0

4. OTHER FEE(S)

Non-English Specification \$130 fee (no small entity discount)

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Other: Filing a Brief in Support of an Appeal

500

SUBMITTED BY

Signature	<i>Michael N. Haynes</i>	Registration No. 40,014 (Attorney/Agent)	Telephone 434-972-9988
Name (Print/Type)	Michael N. Haynes	Date 22 Mar 2006	

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Application # 09/528,693

Attorney Docket # 2000P07518US (1009-026)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant(s) : James Wright et al.
Application # : 09/528,693
Filed : 20 March 2000
Application Title : METHOD, SYSTEM AND APPARATUS FOR PROVIDING
PRODUCT INFORMATION OVER THE INTERNET
Art Unit # : 3627
Latest Examiner : Andrew J. Fischer
Docket No. : 2000P07518US (1009-026)

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REPLY BRIEF UNDER 37 C.F.R. §41.41

Sir:

The Applicant respectfully submits this Reply Brief in response to the Examiner's Answer of 26 January 2006, which was submitted in response to the Appeal Brief filed by Applicant under 37 CFR § 41.37 on 19 October 2005. The Appeal Brief was filed in response to the Office Action of 4 April 2005 finally rejecting each of the pending claims 1-6, all of which claims have been twice rejected.

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Attorney Docket # 2000P07518US (1009-026)

I. GROUNDS OF REJECTION

Claims 1-6 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Cragun (U.S. Patent No. 5,804,803) in view of Ohanian (U.S. Patent No. 6,109,526).

Claims 1-6 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Hudetz (U.S. Patent No. 5,978,773) in view of Ohanian.

II. ARGUMENT**A. Request for Clarification**

The Examiner's Answer, at Page 1, recites [t]his is in response to the appeal brief filed October 19, 2005 ("Forth Appeal Brief") appealing from the Office Action mailed June 29, 2005 ("Third Final Office Action").

Applicant respectfully asks clarification regarding what is meant by the phrase "Forth Appeal Brief" as recited in the Examiner's Answer. Since no dictionary definition of the word "Forth" appear to be apposite in characterizing Applicant's brief filed under 37 C.F.R. § 41.37, Applicant respectfully requests an explanation of what is meant by the phrase "Forth Appeal Brief".

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B. New Issues on Appeal

The Examiner's Answer recites:

[H]owever it is well known that arguments which Appellants could have made but chose not to make in their brief should not be considered by the Board. See 37 C.F.R. §1.192(a) ("Any arguments or authorities not included in the brief will be refused consideration by the Board of Patent Appeals and Interferences, unless good cause is shown.")

Applicant respectfully traverses this assertion as contrary to current law. Applicant respectfully notes that 37 CFR §1.192 was repealed on 13 September 2004 and is, thus, no longer valid law. Applicant respectfully submits that under 41 CFR §41.41, new issues can be raised in this Reply Brief. Thus, Applicant, in this Reply Brief, or the Board of Patent Appeals and Interferences, *sua sponte*, may advance new issues and/or arguments related to this Appeal.

C. General Legal Standards for Obviousness**1. *Prima Facie* Standard**

"To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure." *See* MPEP § 2143.

Moreover, the "Patent Office has the initial duty of supplying the factual basis for its rejection." *In re Warner*, 379 F.2d 1011, 154 USPQ 173, 178 (CCPA 1967), cert. denied, 389 U.S. 1057, *reh'g denied*, 390 U.S. 1000 (1968). "It may not... resort to speculation, unfounded assumptions or hindsight reconstruction to supply deficiencies in its factual basis". *Id.*

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2. Inoperative Combination

It is inappropriate to combine references when the combination “would produce a seemingly inoperative device.” See, *Nat’s Steel Car, Ltd. v. Canadian Pac. Ry., Ltd.*, 357 F.3d 1319, 1339 (Fed. Cir. 2004); *Tec Air Inc. v. Denso Mfg. Mich. Inc.*, 192 F.3d 1353, 1360 (Fed. Cir. 1999) (quoting *In re Sponnoble*, 405 F.2d 578, 587 (CCPA 1969)).

3. Motivation and Suggestion to Combine References

“The examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness.” See, MPEP § 2142. The requirements for fulfilling this burden are explicit and straightforward.

“[T]he examiner must show reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed” (emphasis added). *In re Rouffet*, 149 F.3d 1350, 1357 (Fed. Cir. 1998). To show these reasons, “[p]articular findings must be made”. *In re Kotzab*, 217 F.3d 1365, 1371 (Fed. Cir. 2000). Such factual findings must be supported by “concrete evidence in the record”. *In re Zurko*, 258 F.3d 1379, 1385-86 (Fed. Cir. 2001).

Moreover, a showing of combinability must be clear and particular, *Ruiz v. A.B. Chance Co.*, 234 F.3d 654, 664 (Fed. Cir. 2000) (quoting *In re Dembicza*, 175 F.3d 994, 999 (Fed. Cir. 1999)), because, “obviousness requires proof ‘that the skilled artisan . . . would select the elements from the cited prior art references for combination in the manner claimed’”. *In re Scott E. Johnston*, 435 F.3d 1381 (Fed. Cir. 2006) (quotation omitted) (emphasis added).

Consequently, the Office Action must clearly and objectively prove that the applied references are “reasonably pertinent to the particular problem with which the invention was involved”. See *Ruiz v. A.B. Chance Co.*, 234 F.3d 654, 664 (Fed. Cir. 2000); *Stratoflex, Inc. v.*

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Aeroquip Corp., 713 F.2d 1530, 1535, 218 USPQ 871, 876 (Fed. Cir. 1983); and *Monarch Knitting Machinery Corp. v. Sulzer Morat GmbH*, 139 F.3d 877, 881 (Fed. Cir. 1998).

In addition, the Office Action must clearly and objectively prove some “suggestion, motivation, or teaching in the prior art that would have led a person of ordinary skill in the art to”:

“select the references”;

“select the teachings of [the] separate references”; and

“combine [those teachings] in the way that would produce the claimed invention”.

In re Scott E. Johnston, 435 F.3d 1381 (Fed. Cir. 2006) (internal citations omitted). See also *In re Dance*, 160 F.3d 1339, 1343 (Fed. Cir. 1998) (discussing the “the test of whether it would have been obvious to select specific teachings and combine them as did the applicant”) (emphasis added); and *Interconnect Planning Corp. v. Feil*, 774 F.2d 1132, 1143 (Fed. Cir. 1985) (“When prior art references require selective combination... to render obvious a subsequent invention, there must be some reason for the combination other than the hindsight gleaned from the invention itself.”).

Further, this obviousness standard applies regardless of whether the Office Action relies upon modifying or combining purported teachings.

Although couched in terms of combining teachings found in the prior art, the same inquiry must be carried out in the context of a purported obvious modification of the prior art. The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification.... It is impermissible to use the claimed invention as an instruction manual or template to piece together the teachings of the prior art so that the claimed invention is rendered obvious. This court has previously stated that one cannot use hindsight reconstruction to pick and

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choose among isolated disclosures in the prior art to deprecate the claimed invention.

In re Fritch, 972 F.2d 1260, 23 USPQ 2d 1780, 1783-1784 (Fed. Cir. 1992) (citing *In re Gorman*, 933 F.2d 982, 987, 18 USPQ2d 1885, 1888 (Fed. Cir. 1991); *Interconnect Planning Corp. v. Feil*, 774 F.2d 1132, 1138, 227 USPQ 543, 547 (Fed. Cir. 1985); and *In re Fine*, 837 F.2d 1071, 1075, 5 USPQ 2d 1596, 1600 (Fed. Cir. 1988) (internal quotations omitted) (emphasis added)).

Therefore, the Office Action also must clearly and objectively prove that the “prior art suggested the **desirability**” of that modification or combination. See also *Akamai Techs. v. Cable & Wireless Internet Servs.*, 344 F.3d 1186, 68 USPQ 2d 1186 (Fed. Cir. 2003) (“[w]hen determining the patentability of a claimed invention which combines two known elements, the question is whether there is something in the prior art as a whole to suggest the **desirability**, and thus the obviousness, of making the combination.”) (emphasis added).

D. Claims 1-6: An RFID Tag is Not a Programmable Logic Controller

Applicant respectfully notes an analysis beginning at paragraph 14 of the Examiner’s Answer continuing to erroneously equate a programmable logic controller with a Radio Frequency Identification Device (RFID) tag. In support of that erroneous contention, the Examiner’s Answer recites:

14. Even using Applicants’ definition of ‘PLC’ as found [sic] Appendix C in Applicants’ Forth Appeal Brief, page 4, Paragraph No. 18, that definition is a PLC [sic]. Again, see Landt (U.S. 6,677,852B1), Figure 2A for a typical RFID tag. In particular Applicants state that a PLC is

[A] digitally operating electronic apparatus which uses a programmable memory for the internal storage of instructions for implementing specific functions such as logic, sequencing, timing, counting and arithmetic to

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control through digital or analog input/output modules, various types of machines or processes.

15. Again a RFID tag is a PLC. See again Figure 2A in Landt. In particular this RFID tag is a digitally operating electronic apparatus which uses a programmable memory 206 for the internal storage of instructions for implementing specific functions such as logic 204. Additionally, the RFID tag controls the process of identifying the particular item to which it is attached. Thus, an RFID tag is a PLC.

Applicant respectfully references the entire second Declaration of Dr. Williams in rebutting this factually erroneous assertion. In particular, Dr. Williams' second Declaration provides two definitions for a programmable logic controller, as well a multiple examples to breath additional context into those definitions. At paragraph 16, the second Williams Declaration recites:

one skilled in the art would interpret the term "programmable logic controller (PLC)" to mean a device that follows programmed instructions to provide **automated monitoring and/or control functions over a machine and/or process by evaluating a set of inputs**. A PLC can be used, for example, to **automate complex functions and/or control an industrial process**, for example, in machining packaging, materials handling, and/or other applications.

In addition, at paragraph 17, the second Williams Declaration recites:

one skilled in the art would interpret the term "programmable logic controller (PLC)" to mean "a digitally operating electronic apparatus which uses a programmable memory for the internal storage of instructions for implementing specific functions such as logic, sequencing, timing, counting and arithmetic to control through digital or analog input/output modules, **various types of machines or processes.**"

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When read as a whole, Dr. Williams' second Declaration clearly indicates that a programmable logic controller controls "various types of machines or processes" that are **external to the programmable logic controller**. This must be so since the "various types of machines or processes" are controlled through or via "output modules". Applicant respectfully disclaims any device that might be construed as a "programmable logic controller that can not control "various types of machines or processes" that are **external to the programmable logic controller** "via" one or more "output modules".

Regarding the definition of paragraph 16 of the second Williams' Declaration, an RFID does not "provide automated monitoring and/or control functions over a machine and/or process" that is **external to the device**, and thus is not a "programmable logic controller". In addition, an RFID could not be used "to automate complex functions and/or control an industrial process, for example, in machining packaging, materials handling, and/or other applications", and therefore can not be a "programmable logic controller".

Regarding the definition in paragraph 17 of the second Williams' Declaration, an RFID does not control (i.e., provide instructions to), any external machines or processes via output modules. In addition, Applicant respectfully asks, what are the "various types" (in plural) "of machines or processes" (in plural) **external to the programmable logic controller** that the "RFID tag" of Landt is capable of controlling? The Examiner's Answer only alleges a single type of internal process allegedly controllable by the RFID tag of Landt.

Applicant respectfully submits that the "RFID tag" allegedly disclosed in Landt does not teach or suggest, expressly or inherently, a "programmable logic controller".

E. All Claims Do Not Stand or Fall Together With Claim 1

Page 5 of the Examiner's Answer recites "[i]n accordance with 37 C.F.R. §41.36(vii) and because Applicants have not provided separate arguments and headings for the individual claims on appeal, all claims in the obviousness rejection stand or fall with claim 1.]"

As an initial matter, Applicant respectfully notes that 37 C.F.R. §41.36(vii) was repealed

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effective 13 September 2004 and is no longer valid law. Applicant respectfully notes that under the present law of 37 C.F.R. 41.37 (c)(vii) separate arguments and headings can be presented in this Reply Brief submitted under 37 C.F.R. 41.41. Accordingly, Applicant respectfully submits separate arguments for each of independent claim 1 and dependent claim 6 regarding each rejection.

F. The Rejection of Claims 1-6 Under 35 U.S.C. §103(a) in View of Cragun and Ohanian

Claim 1 recites, yet Ohanian fails to teach or suggest, expressly or inherently, “a predetermined product coupleable to a programmable logic controller, the programmable logic controller couplable to a network, said indicator associated with said predetermined product and indicative of a network web page where product information is provided for said predetermined product, the network web page comprising an on-line product support help window.”

Instead, Ohanian allegedly recites “the present invention embodies a data input apparatus that obtains information relative to a target. The apparatus includes a processor, a wireless data receiver, and an associated data capture engine. The wireless data receiver is coupled to the processor and receives electromagnetic data from at least one resonator, such as a dipole, positioned relative to the target. The data capture engine is also coupled to the processor and receives data from an associated data carrier, such as a machine-readable symbol...” See column 2 lines 10-19.

Paragraphs 18-25 of Dr. Williams’ first Declaration, and paragraphs 25-28 of Dr. Williams’ second Declaration, each provide evidence that one skilled in the art would find that Neither Cragun nor Ohanian expressly or inherently teach or suggest “...a predetermined product coupleable to a **programmable logic controller**, the programmable logic controller couplable to a network, said indicator associated with said predetermined product and indicative of a network web page where product information is provided for said predetermined product, the network web page comprising an on-line product support help window.” Thus, even if combinable or modifiable, the applied references do not expressly or inherently teach or suggest every limitation

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of the claims.

Further, attempting to combine Cragun with Ohanian would render one or the other inoperative. For example, attempting to replace Cragun's "scanning device" (see Fig. 1A element 118) with Ohanian's "wireless data receiver" (see col.2, lines 14-15) would render Cragun's system inoperative for its intended function of scanning barcodes. Similarly, replacing Ohanian's "wireless data receiver" with Cragun's "scanning device" would render Ohanian unable to obtain information from RF tags.

Thus, there would have been no motivation or suggestion to modify or combine the applied references, and one skilled in the art would not have had a reasonable expectation of success in combining or modify the applied references. In addition, the applied references do not expressly or inherently teach or suggest every limitation of the independent claims, and consequently fail to establish a *prima facie* case of obviousness.

Moreover, the Examiner's Answer and each Office Action presented each fail to provide a proper suggestion and motivation to combine Cragun with Ohanian. Regarding the combination, the Examiner's Answer recites "[s]uch a modification would have helped get the data more quickly if the bar codes became obscured and would have allowed the tags to be reused because they [sic] electronically rewritten with data thereby overcoming the permanency of barcode symbols." *See Page 9.* This unsupported speculation does not satisfy the requirement of a "suggestion, motivation, or teaching in the prior art that would have led a person of ordinary skill in the art to": "select the references"; "select the teachings of [the] separate references"; and "combine [those teachings] in the way that would produce the claimed invention".

Accordingly, it is respectfully submitted that Cragun in view of Ohanian does not render obvious independent claim 1. Furthermore, because independent claim 1 is not rendered obvious by either applied combination, it stands that claims 2-6, each ultimately depending from claim 1, are also not rendered obvious by Cragun in view of Ohanian.

Consequently, reversal of the rejection of claims 1-6 is respectfully requested.

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G. The Rejection of Claim 6 Under 35 U.S.C. §103(a) in View of Cragun and Ohanian

Claim 6 recites, yet the applied portions of Ohanian fail to teach or suggest, expressly or inherently, “the programmable logic controller is coupled to the network via means for automatically interfacing to the Internet to access said web page based on said indicator.” As an initial matter, under the controlling definitions comprised in the second Declaration of Dr. Williams, Applicant respectfully submits that the applied portions of Ohanian do not teach or suggest a “programmable logic controller”. Consequently, the applied portions of Ohanian cannot teach or suggest, “the programmable logic controller is coupled to the network”. In addition, the applied portions of Ohanian do not teach or suggest a “means for automatically interfacing” “the programmable logic controller” to “the Internet”. Thus, the applied portions of Ohanian do not teach or suggest “the programmable logic controller is coupled to the network via means for automatically interfacing to the Internet to access said web page based on said indicator.” The applied portions of Cragun do not overcome these deficiencies of Ohanian. Consequently, reversal of the rejection of claim 6 is respectfully requested.

H. The Rejection of Claims 1-6 Under 35 U.S.C. §103(a) in View of Ohanian and Hudetz

Hudetz allegedly recites “[a] system and method for using identification codes found on ordinary articles of commerce to access remote computers on a network. In accordance with one embodiment of the invention, a computer is provided having a database that relates Uniform Product Code (‘UPC’) numbers to Internet network addresses (or ‘URLs’). To access an Internet resource relating to a particular product, a user enters the product’s UPC symbol manually, by swiping a bar code reader over the UPC symbol, or via other suitable input means. The database retrieves the URL corresponding to the UPC code. This location information is then used to access the desired resource.” *See Abstract.*

Paragraphs 22-29 of Dr. Williams’ first Declaration, and paragraphs 25-31 of Dr. Williams’ second Declaration, each provide evidence that one skilled in the art would find that

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Neither Ohanian nor Hudetz expressly or inherently teach or suggest “an indicator contained in a memory ... a predetermined product coupleable to a programmable logic controller, the programmable logic controller couplable to a network.”

Further, attempting to combine Hudetz with Ohanian would render one or the other inoperative. For example, attempting to replace Hudetz’ “bar code reader” (see col. 3, line 32) with Ohanian’s “wireless data receiver” (see col. 2, lines 14-15) would render Hudetz’ system inoperative for its intended function of scanning barcodes. Similarly, replacing Ohanian’s “wireless data receiver” with Hudetz’ “bar code reader” would render Ohanian unable to obtain information from RF tags.

Thus, would have been no motivation or suggestion to modify or combine the applied references, and one skilled in the art would not have had a reasonable expectation of success in combining or modify the applied references. In addition, the applied references do not expressly or inherently teach or suggest every limitation of the independent claims, and consequently fail to establish a *prima facie* case of obviousness.

Moreover, the Examiner’s Answer and each Office Action presented each fail to provide a proper suggestion and motivation to combine Hudetz with Ohanian. Regarding the combination, the Examiner’s Answer does not provide a “suggestion, motivation, or teaching in the prior art that would have led a person of ordinary skill in the art to”: “select the references”; “select the teachings of [the] separate references”; and “combine [those teachings] in the way that would produce the claimed invention”.

Accordingly, it is respectfully submitted that Ohanian in view of Hudetz does not render obvious independent claim 1. Furthermore, because independent claim 1 is not rendered obvious by either applied combination, it stands that claims 2-6, each ultimately depending from claim 1, are also not rendered obvious by Ohanian in view of Hudetz.

Consequently, reversal of the rejection of claims 1-6 is respectfully requested.

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I. The Rejection of Claim 6 Under 35 U.S.C. §103(a) in View of Ohanian and Hudetz

Claim 6 recites, yet the applied portions of Ohanian fail to teach or suggest, expressly or inherently, “the programmable logic controller is coupled to the network via means for automatically interfacing to the Internet to access said web page based on said indicator.” As an initial matter, under the controlling definitions comprised in the second Declaration of Dr. Williams, Applicant respectfully submits that the applied portions of Ohanian do not teach or suggest a “programmable logic controller”. Consequently, the applied portions of Ohanian cannot teach or suggest, “the programmable logic controller is coupled to the network”. In addition, the applied portions of Ohanian do not teach or suggest a “means for automatically interfacing” “the programmable logic controller” to “the Internet”. Thus, the applied portions of Ohanian do not teach or suggest “the programmable logic controller is coupled to the network via means for automatically interfacing to the Internet to access said web page based on said indicator.” The applied portions of Hudetz do not overcome these deficiencies of Ohanian. Consequently, reversal of the rejection of claim 6 is respectfully requested.

J. Lexicography

Applicant respectfully notes a litany of legally erroneous assertions regarding lexicography in the Examiner’s Answer between paragraphs 28 and 35. Applicant respectfully notes that these assertions are generally not in harmony with current law.

On 12 July 2005, the Federal Circuit, in *Phillips v. AWH Corp.*, 415 F.3d 1303, 75 USPQ2d 1321 (Fed. Cir. 2005) (*en banc*), *cert. denied*, 2006 U.S. LEXIS 1154 (U.S. Feb. 21, 2006) clarified, *inter alia*, that:

1. “[t]he Patent and Trademark Office (‘PTO’) determines the scope of claims in patent applications not solely on the basis of the claim language, but upon giving claims their broadest reasonable construction ‘in light of the specification as it would be interpreted by one of ordinary skill in the art’” (*Id.* at 1316);

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2. the words of a claim “are generally given their ordinary and customary meaning” (*Id.* at 1312);
3. the ordinary and customary meaning of a claim term is “the meaning that the term would have to a person of ordinary skill in the art in question at the time of the invention, i.e., as of the effective filing date of the patent application” (*Id.* at 1313);
4. “the person of ordinary skill in the art is deemed to read the claim term not only in the context of the particular claim in which the disputed term appears, but **in the context of the entire patent, including the specification**” (*Id.*);
5. even “the context in which a term is used in the asserted claim can be highly instructive” (*Id.* at 1314);
6. “the specification may reveal a special definition given to a claim term by the patentee that differs from the meaning it would otherwise possess. In such cases, **the inventor’s lexicography governs**” (*Id.* at 1316);
7. even “when guidance is not provided in explicit definitional format, **the specification may define claim terms by implication** such that the meaning may be found in or ascertained by a reading of the patent documents” (*Id.* at 1321);
8. an “invention is construed not only in the light of the claims, but also with reference to the file wrapper or prosecution history in the Patent Office” (*Id.* at 1317 (*citing Graham v. John Deere Co.*, 383 U.S. 1, 33 (1966)); and
9. the “prosecution history... consists of the complete record of the proceedings before the PTO and **includes the prior art cited** during the examination of the patent” (*Id.* at 1317).

Applicant respectfully submits that as an *en banc* opinion, *Phillips v. AWH Corp.* is binding precedent, which supersedes inconsistent prior Federal Circuit decisions, CCPA decisions, lower court decisions, BPAI decisions, and even binds subsequent Federal Circuit panel decisions. Absent a contrary adjudication by the United States Supreme Court, legislation

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by the United States Congress, or a subsequent *en banc* opinion by the Federal Circuit, *Phillips v. AWH Corp.* is the law regarding claim construction and lexicography.

Applicant respectfully submits that the contention that the Second Declaration of Dr. Williams is new matter (as asserted in paragraph 29 of the Examiner's Answer) is contrary to the doctrine enunciated in *Phillips v. AWH Corp.* that the ordinary and customary meaning of a claim term is "the meaning that the term would have to a person of ordinary skill in the art in question at the time of the invention, i.e., as of the effective filing date of the patent application" (*Id.* at 1313). The Second Declaration of Dr. Williams provides persuasive evidence regarding "the meaning that the term would have to a person of ordinary skill in the art in question at the time of the invention." Accordingly the contention that the Second Declaration of Dr. Williams is new matter is utterly baseless and contrary to law.

In addition, the assertion that "claim terms are fixed on filing" (as asserted in paragraph 29 of the Examiner's Answer) is contrary to the doctrines enunciated in *Phillips v. AWH Corp.* Applicant respectfully traverses the reasoning of this assertion to the extent that is not consistent with *Phillips v. AWH Corp.* In particular, if "claim terms are fixed on filing," why would the *Phillips v. AWH Corp.* court state that an "invention is construed not only in the light of the claims, but also with reference to the file wrapper or prosecution history in the Patent Office" (*Id.* at 1317 (*citing Graham v. John Deere Co.*, 383 U.S. 1, 33 (1966)))?

Moreover, the assertion that "the lexicographic declaration must be in the specification" (as asserted in paragraph 34 of the Examiner's Answer) is diametrically at odds with the doctrines enunciated in *Phillips v. AWH Corp.* In particular, *inter alia*, even "when guidance is not provided in explicit definitional format, the specification may define claim terms by implication such that the meaning may be found in or ascertained by a reading of the patent documents" (*Id.* at 1321). To reiterate, the ordinary and customary meaning of a claim term is "the meaning that the term would have to a person of ordinary skill in the art in question at the time of the invention, i.e., as of the effective filing date of the patent application" (*Id.* at 1313).

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In addition, “the person of ordinary skill in the art is deemed to read the claim term not only in the context of the particular claim in which the disputed term appears, but **in the context of the entire patent, including the specification**” (*Id.*) and “**with reference to the file wrapper or prosecution history in the Patent Office**” (*Id.* at 1317).

Accordingly, Applicant respectfully requests that the Second Declaration of Dr. Williams control in the examination of each of claims 1-6 with respect to construing the claim phrase “programmable logic controller” and requests a written confirmation that the discussion regarding lexicography in the Examiner’s Answer is legally erroneous.

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SUMMARY

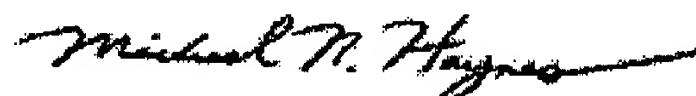
In view of the above, Applicants submit that all claims on appeal distinguish over the applied art and respectfully request that the rejections of these claims should be reversed.

Applicants therefore respectfully request that the Board of Patent Appeals and Interferences reverse the decision rejecting claims 1-6 and direct that the application be passed to issue.

The Office is hereby authorized to charge any additional fees or credit any overpayments under 37 C.F.R. §1.16 or §1.17 to Deposit Account No. 19-2179. The Examiner is invited to contact the undersigned at 434-972-9988 to discuss any matter regarding this application.

Respectfully submitted,

Michael Haynes PLC



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Michael N. Haynes
Registration No. 40,014

1341 Huntersfield Close
Keswick, VA 22947
Telephone: 434-972-9988
Facsimile: 815-550-8850